



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,942	03/05/2002	Christopher L. Parmelee	D-1154R1	5494
28995	7590	07/19/2007		
RALPH E. JOCKE walker & jocke LPA 231 SOUTH BROADWAY MEDINA, OH 44256			EXAMINER HEWITT II, CALVIN L	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 07/19/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/683,942

Applicant(s)

PARMELEE ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3-9-07, 10-19-05</u>  | 6) <input type="checkbox"/> Other: _____                          |

***Status of Claims***

1. Claims 1-28 have been examined.

***Examiner's Comments***

2. In general Applicant describes the claimed apparatus using the terms "operative to [do something]". However, this does not sufficiently differentiate the claims from the prior art. Claim 16 recites "a computer processor is operative to store a digitally signed copy of the electronic document on the portable storage medium". However, to one of ordinary skill, all the prior art is required to show, for example, is computer with a floppy drive, CD-R or DVD-R drive, or a slot for receiving flash memory, as either of these embodiments is *operative to store* not only a signed electronic document, but any computer readable data.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is directed to an apparatus. However, claim 1 also recites method steps. For example, claim 1 recites "wherein the computer processor is operative to output a visual representation of at least one electronic document through the display device *responsive to at least one first input* through the at least one input device, and wherein the computer processor is operative *to cause at least one electronic document to be digitally signed with a private key responsive to at least one second input* through the at least one input device." Similarly claim 2 recites "wherein the at least one second input *includes the confirming input*", claim 5 recites "wherein the computer processor is operative to cause the card reader to read *at least one account number from a card*, wherein the computer processor is *operative to cause a remote server to access the private key responsive to the at least one account number read from the card*", claim 15 recites "wherein the computer processor is operative *to retrieve the electronic document* from the portable storage medium, claim 17 recites "wherein the computer processor is operative to communicate with the at least one server, *wherein the at least one server is operative to generate a digital signature responsive to the private key*", and claim 19 recites "wherein the computer processor is operative to generate and send a one-way hash of the electronic

document to the at least one server, wherein the at least one server is further operative to generate the digital signature responsive to the one-way hash, wherein the computer processor is operative to attach the digital signature to the electronic document". However, it has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)).

Claims 20, 21, 23-25, 27 and 28 are also rejected as each recites language similar to claim 19.

Claims 2-28 are also rejected as each is depends from claim 1.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes, U.S. Patent No. 6,848,048.

As per claims 1-28, Holmes teaches an apparatus comprising:

- an ATM, computer processor, an input device and a display device (column 2, lines 38-53; column 3, lines 7-14; column/line 3/38-4/14; column 4, lines 29-51; column 5, lines 38-65; column 6, 30-62)
- a cash dispenser, card reader (column 2, lines 43-45; column 4, lines 55-60)
- a computer processor causing an electronic document to be time-stamped (column 2, lines 38-53; column 3, lines 28-35; column/line 7/62-8/10) and retrieving a document from, and sending a document to, an external source (column 3, lines 5-35; column 7, lines 63-67; column 8, lines 3-5)
- a communication port connected to the computer processor (figure 2; column 3, lines 5-27; column 4, lines 41-43; column/line 7/62-8/10)
- signing a document with a private key (column/line 4/44-5/29; column 7, lines 45-53)
- storage device drive connected to the computer processor (figure 2; column 4, lines 28-38) and retrieving an electronic document from a portable storage medium (column 4, lines 28-36)
- storing a digitally signed copy of a document (column 4, lines 28-36)

Art Unit: 3621

- the computer processor communicating with a remote server (figure 2; (column 3, lines 5-35; column 7, lines 63-67; column 8, lines 3-5)
- retrieving a private key from a portable computing device (i.e. smart card) and signing the document using the obtained key (column 7, lines 45-50) and generating a digital signature by the portable device (column 5, lines 10-21; column 7, lines 48-50)

Applicant attempts to further limit the claimed display device by describing what is displayed. However, this is representative of non-functional descriptive material as the electronic document is not functionally related to the display device (MPEP 2106 II; *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994)) and therefore cannot be used to differentiate Applicant's device from the prior art display device of Holmes (column 4, lines 38-43). Regarding, the process steps of digitally signing the electronic document (see also *IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)), this is functional language and while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)), hence Holmes (figure 2) is

sufficient in terms of prior art. Claims 2, 5, 9, 15, 17, 19, 20, 21, 23-25, 27 and 28 also express steps in terms of functional language.

As per claim 4, ATMs with signature pads are old and well known therefore, it would have been obvious to one of ordinary to use a signature pad or other input device to enter data into the ATM.

As per claim 6, claim 1, from which claim 6 depends, is directed to an apparatus. Claim 6 on the other hand, is directed to an account number. However, this is representative of non-functional descriptive material as the account number is not functionally related to the computer processor (MPEP 2106 II; *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994)) and therefore cannot be used to differentiate Applicant's processor from the prior art processor of Holmes (figure 2; column 3, lines 43-63). Claims 8 (i.e. an ATM façade upon which data is printed) and 13 (i.e. words in the document) (see also column 3, lines 28-44 and column 5, lines 28-44 where Holmes describes creating a document) recite similar language

As per claims 11 and 12, the external source is not part of the apparatus of claim 1, and therefore cannot be relied upon to distinguish the claimed apparatus from the apparatus of Holmes (figure 2). Claim 17-28 recites similar language.



As per claim 19, it is rejected under 112 second paragraph for not clearly defining the claim as a method or an apparatus (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)). In addition, claim 19 recites language directed to processes performed by a server. However, as the server is not part of the apparatus described by claims 1, 3 or 17 it cannot be relied upon to distinguish the claimed apparatus from the apparatus of Holmes (figure 2). Therefore, as Holmes teaches a computer device for generating a hash function (column 2, lines 54-65; column 5, lines 10-15; column 7, lines 35-45), wherein the computer is also operative to receive a digital signature and attach the signature to a document (column 2, lines 54-65; column 5, lines 32-44; column 7, lines 50-55; column 8, lines 17-45), Holmes is sufficient as prior art. Claims 23 and 27 (column 5, lines 10-21; column 7, lines 48-50) are also rejected as each recites language similar to claim 19.

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes, U.S. Patent No. 6,848,048 in view of Otway, U.S. Patent No. 6,192,130.

As per claim 20, Holmes teaches storing a private key on a computing device wherein the device uses the key to digitally sign a document (column 7, lines 44-46). However, Holmes does not specify how the computing device obtained the key. Otway teaches a remote server generating an encryption key

pair and transmitting a private key of the pair to a computing device (column/line 1/35-2/15). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Holmes and Otway in order to allow a user whose private key was compromised to obtain a new private key ('130, column 1, lines 35-67).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Donohue et al. disclose an ATM with a signature pad

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

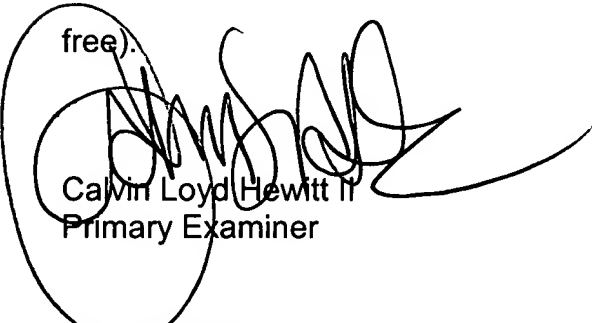
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public

Art Unit: 3621

PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).



Calvin Loyd Hewitt II  
Primary Examiner

July 12, 2007